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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,269	06/27/2003	Isamu Tsumori	1403-0252P	4725

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EXAMINER

MAKI, STEVEN D

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 12/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/607,269

Applicant(s)

TSUMORI ET AL.

Examiner

Steven D. Maki

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 December 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see advisory action attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): see advisory action attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,4,5,8-10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see advisory action attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: Interview Summary Paper No. 121605.

advisory action attachment

new issues

The new issues include:

- (1) in claim 1, adding --plate material or--;
- (2) in claims 4, 9 and 10, changing "plate-like material" to --plate material--;
- (3) in claim 9, deleting "formed by the process of claim 1" without adding the subject matter relating to "extruding ... in a tube shape"; and
- (4) in claim 9, adding --wherein said sheet is cut perpendicularly in the extrusion direction to obtain pieces, and each piece of said sheet is rotated 90° and the rotated pieces are laminated together to form the tread--.

rejections overcome

The 103 rejection of claims 1, 4-5 and 8-10 over Goettler et al, Tajima et al, Japan 718 and Japan 034 have been withdrawn. See comments in the Interview Summary paper no. 121605.

remarks

With respect to the 112 first paragraph rejection, applicant states: "At pages 2-4 of the Office Action, the Examiner asserts that the following limitation in claim 4 is not enabled: ...". This statement is irrelevant since the 112 first paragraph rejection is directed at the combination of extruding into a tube and the equation including the terms $E\alpha$, $E\beta$ **instead of** the equation per se.

With respect to the 112 first paragraph non-enabling rejection of claims 4 and

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8-10, applicant argues that it is clear that the elastic modulus of the 2 mm sheet described at page 19 lines 1-11 of the specification is being described. This argument is not persuasive since it fails to address how an equation for one embodiment (the roller embodiment) is applied to a different embodiment (the tube embodiment) when the complex elastic modulus E_{α} are completely different.

With respect to page 19 lines 1-11 of the specification, the following comments are made: Claims 4 and 9 require the subject matter of the tube shaped embodiment and the equation including the terms E_{α} , E_{β} . For example, claim 4 recites "extruding ... into a tube" and " $60 \leq (E_1 - E_{\beta}) / (E_{\alpha} - E_{\beta}) \times 100 \leq 100$ ". Page 19 lines 1-11 is part of the description of the examples for the roller embodiment. The terms E_{α} and E_{β} are determined for the roller embodiment (table 1) but not the tube shaped embodiment (table 2). It is acknowledged that the original disclosure has literal support for the combination of "extruding ... into a tube" and " $60 \leq (E_1 - E_{\beta}) / (E_{\alpha} - E_{\beta}) \times 100 \leq 100$ ". See original claim 4. However, the original disclosure fails to teach *how* to implement this equation in the tube shaped embodiment. It is noted again that in the examples for the tube shaped embodiment, applicant did not determine E_{α} , E_{β} . The terms E_{α} , E_{β} make no sense in the tube shaped embodiment because the fiber orientation in the tube shaped embodiment is perpendicular to the extrusion direction whereas the fiber orientation in the roller embodiment is in the extrusion direction.

With respect to the 112 second paragraph rejection, applicant argues and the examiner agrees that there is no requirement to delineate each and every non-critical component of the invention. This argument however is off point. The issue is the

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claimed scope of protection afforded by the language of claims 1 and 4. Is claim 1 broadly directed to making a rubber sheet or is claim 1 limited to making a studless tire? It appears that the latter is required since "preparing a rubber sheet" was changed to --preparing a studless tire having a tread comprising a rubber sheet-- in the amendment filed 6-14-05.

Applicant argues that Japan 718 pertains to a summer tire that is utterly different from the studless tire of the present invention. This argument is not persuasive since applicant has failed to explain where Japan 718 requires tire studs. The description of "studless tire" fails to require tire structure different from Japan 718's tire, which has no studs.

Applicant argues that the product of the invention provides for advantageous properties as evidenced by the comparative test results summarized in the present application. The results in the specification have been considered but are not persuasive of non-obviousness because the claimed tire has not been compared with Japan 718's tire. Comparative examples 5 and 8 did not use the method of forming the tread disclosed by Japan 718.

Applicant's argument that Japan 034 does not disclose short fibers is incorrect. Japan 034's title for example is "Manufacturing of a short fiber reinforced elastic sheet".

With respect to applicant's request on page 13 of the after final amendment filed 12-6-05, the drawings filed 6-23-03 are accepted by the examiner.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven D. Maki whose telephone number is (571) 272-1221. The examiner can normally be reached on Mon. - Fri. 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven D. Maki
December 27, 2005


12-27-05
STEVEN D. MAKI
PRIMARY EXAMINER